



Atty. Dkt. No. 035451-0185 (3731.Palm)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants: Fraser et al.

Title: INTERCHANGEABLE
DISPLAY MODULES FOR
PORTABLE HANDHELD
DEVICES

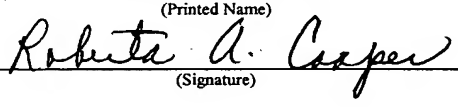
Appl. No.: 10/085,310

Filing Date: 2/28/2002

Examiner: Abdulsalam, Abbas I.

Art Unit: 2677

Confirmation Number: 7608

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Sir:

Transmitted herewith is the following document for the above-identified application.

[X] Reply Brief under C.F.R. § 41.41 (6 pages).

Respectfully submitted,

Date 7/25/2006

By 

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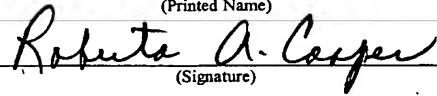
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Sir:

Under the provisions of 37 C.F.R. § 41.41, this Reply Brief is being filed in response to the Examiner's Answer dated May 25, 2006. The Appeal Brief was filed March 6, 2006, in response to a Final Action dated October 4, 2005.

REMARKS

With respect to independent claims 1, 15, 22, and 26, the Examiner's Answer included the following response to Appellants' arguments in the Appeal Brief:

Appellant argues that Moriconi does not teach a hand held computing device, and no proper combination of Moriconi with knowledge generally available to one of ordinary skill in the art teaches or suggests a hand held computing device of claims 1-15 and 17-29. The examiner respectfully disagrees with appellant's arguments. Moriconi teaches a notebook computer (11) and indicates that the notebook computer (11) is applicable for portable computers (col. 1, lines 17-19), and alteration and different arrangement can be made with respect to the notebook computer (11) (col. 6, lines 35-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Moriconi's notebook computer (11) by altering its dimensional parameters to fit the desired size, as taught by Moriconi.

Appellants respectfully disagree. The first passage of Moriconi et al. cited by the Examiner contains only a general statement that "[t]his invention is in the field of architecture of portable computers, and pertains in particular to apparatus and methods of interfacing removable physical displays to portable computers." See Moriconi et al., col. 1, lines 17-19. Appellants submit that such a broad reference to portable computers in general fails to establish any motivation or suggestion to one skilled in the art to combine knowledge generally available with the teachings of Moriconi et al. to arrive at the subject matter of the claimed invention. Despite Appellants' previous discussions of particular attributes unique to handheld computers (e.g., that a "handheld computer" is "a computer that can conveniently stored in a pocket (of sufficient size) and used while you are holding it"), the Examiner seems to imply that there is essentially no difference between a laptop computer (e.g., the device shown in Moriconi et al.) and a handheld computer. Appellants submit that the Examiner has improperly essentially equated laptop or notebook computers and handheld computers, and still has provided no support or evidence for the assertion that a person of ordinary skill in the art would apply the teachings of Moriconi et al. regarding laptop computers to arrive at the handheld computer of the claimed invention.

The second passage from Moriconi et al. relied on by the Examiner provides only broad boilerplate language stating that “many changes may be made in the embodiments of the invention as described above without departing from the spirit and scope of the invention.” Appellants submit that such language provides no motivation or suggestion to a person of ordinary skill in the art to make any specific modifications to Moriconi et al., much less the modifications required to transform the laptop computer of Moriconi et al. into the handheld computer of the claimed invention.

The Examiner further stated that

[i]n addition, it would have been an obvious matter of design choice to make Mariconi’s portable computer (11) shown in Fig. 1 a handheld device, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art[.] In re Rose, 105 USPQ 237 (CCPA 1955).

Appellants disagree, and submit that the claimed invention does not involve a “mere change in size of a component” as asserted by the Examiner, but rather involves addressing challenges specifically associated with handheld computing devices (e.g., screen size limitations) that are not present in all portable computers, such as the laptop computer as taught by Moriconi et al. For example, Appellants’ specification states at paragraph [0003] that “the size of the handheld computing device is generally compact and correspondingly, the visual display is smaller than the size of a standard computer monitor. The small size of the screen allows handheld computing devices to be portable, but less than ideal for viewing complex images of documents. The small size of the screen has necessitated that handheld computing devices focus on displaying abbreviated or simplistic content.” In contrast, the laptop or notebook computer of Moriconi et al. has a display which is relatively large and could easily be used for viewing complex images of documents, for example. Thus, Appellants submit that the Examiner has failed to establish that the claimed invention involves a mere “change in size of a component.”

The Examiner further addressed claims 1, 15, 22, and 26 in the following remarks.

Furthermore, in response to applicant’s arguments, the recitation “a hand held computing device” has not been given patentable weight because it

occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or an intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Appellants respectfully disagree with the Examiner's decision to not accord patentable weight to the term "handheld computing device" because "it occurs in the preamble." Appellants first point out that "[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." Manual of Patent Examining Procedure ("MPEP") § 2111.02; See also, Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed. Cir. 1999). Secondly, "reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation." MPEP § 2111.02 (quoting Catalina Mktg. Int'l v. Coolsavings.com, Inc., 289 F.3d at 808-09 (Fed. Cir. 2002)). Appellants submit (1) that the preamble of claims 1, 15, 22, and 26 limits the structure of the claimed invention to a handheld computer that "can be conveniently stored in a pocket" and (2) that the preamble has been relied upon during prosecution to distinguish the claimed invention from Moriconi et al. Accordingly, Appellants submit that the Examiner has incorrectly failed to accord patentable weight to the preamble of claims 1, 15, 22, and 26.

With respect to dependent claims 2, 20, and 21, the Examiner's Answer included the following response to Appellants' arguments in the Appeal Brief:

Appellant argues that Moriconi does not teach a wireless communication interface. The examiner respectfully disagrees with appellant's arguments.

Moriconi instead teaches a multi-pin electrical connector 39 (Fig. 2), shown as male part 39' and female part 39'' (Fig. 3). However, because the multi-pin connector and the desired wireless interface were art-recognized equivalents at the time of the invention, one of ordinary skill in the art would have found it obvious to substitute a wireless communication interface for multi-pin connector (39).

Appellants respectfully disagree, and submit that the "multi-pin connector (39)" of Moriconi et al. and the wireless communication interface of the claimed invention were not

“art-recognized equivalents” at the time of the invention for the purpose of enabling wireless communication between a handheld computer and a detachable display. Rather, the multi-pin connector is used with a display that is coupled to and supported by the housing of the laptop or notebook computer, and therefore there is no need for a wireless connection. Accordingly, Appellants submit that, contrary to the Examiner’s conclusion, it would not have been obvious to one of ordinary skill in the art “to substitute a wireless communication interface for multi-pin connector.”

With respect to dependent claims 4, 5, 23, and 24, the Examiner’s Answer included the following response to Appellants’ arguments in the Appeal Brief:

Appellant argues that Moriconi does not teach flexible, expandable and foldable displays. The examiner respectfully disagrees with the appellant’s arguments.

Moriconi teaches a display module (13) that could be a flat panel display (43) as shown in Fig. 4 (col. 4, line 62).

It would have been an obvious matter of design choice to make Moriconi’s display module (13) flexible and foldable since such modifications are some of numerous configurations a person of ordinary skill in the art would find obvious based on changing a form or shape. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Appellants disagree with the Examiner’s assertion that “it would have been an obvious matter of design choice” to modify Moriconi et al. to include a flexible, expandable, or foldable display. The need for a flexible, expandable, or foldable display is of particular importance for a handheld computing device. In fact, the teachings of Moriconi et al. of a laptop or notebook computer, suggest no advantage for providing an expandable, flexible, or foldable display, because the laptop or notebook computer of Moriconi et al. is already a large enough size for a typical user and therefore an expandable or foldable display is not required. Accordingly, Appellants submit that the Examiner has failed to establish any motivation or suggestion to modify the display of Moriconi et al. to be flexible, expandable, or foldable, as in the claimed invention.

CONCLUSION

In view of the foregoing, as well as in view of the Argument set forth in Appellants' Appeal Brief, Appellants respectfully request that the Board reverse all claim rejections and indicate that a notice of allowance respecting all pending claims should be issued.

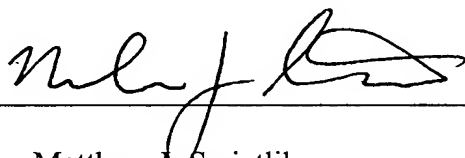
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447.

Should no proper payment be enclosed herewith, as by a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is hereby authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 7/23/2006

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